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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/986,134 Confirmation No. : 4659
Applicant : Rodolfo Antonio GOMEZ
Filed : November 7, 2001
TC/A.U. : 1742
Examiner : Wilkins III, Harry D.
Docket No. : 056284.50645US
Customer No. : 23911
Title : Compound Electrode for Electrochemical Processes

PETITION UNDER 37 C.F.R. §1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. §1.181, Applicants Petition from the decision of the Examiner in the Advisory Action of April 23, 2004 in which an Amendment filed on April 6, 2004, was denied because it was deemed not to place the application in better form for Appeal by materially reducing or simplifying the issues for appeal.

Among other rejections, claim 9 was rejected under 35 U.S.C. 102 as anticipated by Mazanec et al. U.S. Patent No. 5,693,212 in the first Office Action of June 4, 2003. Subsequently, in an Amendment filed October 6, 2003, claim 9 was amended with an inadvertent error in the typing of the first two lines of claim 9 which were not the lines being amended.

As a result, the Final Rejection of November 28, 2003, which was reset to January 6, 2004 contained a rejection of claims 9 and 10 because of this

inadvertent error. The rejection was a 35 U.S.C. 112, first paragraph, rejection based on the omission from the first two lines of claim 9 in the Amendment.

Subsequently, in an Amendment After Final dated April 6, 2004, Applicants corrected claim 9 with respect to the first two lines and provided arguments with respect to other rejections in the application.

The Advisory Action of April 23, 2004, indicates that the filed Reply overcame the rejection of claims 1, 4 and 6 over Mazanec et al. but the Amendment would not be entered because it would require the reinstatement of the rejection of claim 9 on the same grounds as the first Office Action of June 4, 2003.

Applicants respectfully request that this decision of the Examiner in refusing to entry the Amendment be reversed on the grounds that there are no new issues raised by the Amendment as the claim 9, in its present form, was originally considered and rejected over the reference to Mazanec et al. Furthermore, the acknowledged overcoming of the rejection of claims 1, 4 and 6 over Mazanec et al. constitutes a material reduction in the issues for appeal. If the Examiner desires to maintain a rejection of claim 9 as in the same Office Action it is not a result of any new issues and, additionally the 35 U.S.C. 112, rejection has been overcome.

According to the statement concluding the Advisory Action on page 2, the fact that Mazanec et al. would be applied to reject amended claim 9 constitutes a new ground of rejection and thus the Amendment is not entered.